

REMARKS/ARGUMENTS

Claims 1-20 are pending in the present application and remain in this application for prosecution. None of the claims has been amended. A Listing of Claims has been included for the convenience of the Examiner.

The Office Action states that claims 1-20 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,604,740 to Singer *et al.* (“Singer”) in view of U.S. Patent No. 6,050,895 to Luciano *et al.* (“Luciano”). However, claims 1 and 10 (which are the only independent claims) have been rejected only over Singer. Dependent claims 2-3, 9, 11, 14, 17-18, and 20 have also been rejected only over Singer.

Only dependent claims 4-8, 12-13, 15-16, and 19 have been rejected over both Singer and Luciano. The Applicant respectfully notes that the Office Action has failed to address any of the arguments presented in the previous response of April 30, 2008, regarding the patentability of the claims in view of Luciano.

I. Rejections In View of Singer

A. The Cited Art Fails To Disclose Replacing “Winning” Symbols

Claim 1 is directed to “replacing one or more of the winning symbols in the first array that form the first winning combination with a randomly determined replacement symbol to form a second array.” The combination of Singer in view of Luciano fails to disclose this claim element. Claim 10 is directed to a controller operative to “replace the first winning symbol with a randomly determined first replacement symbol to form a second array.”

The Office Action alleges that Singer discloses these claim elements at “col. 5, lines 1-6,” which states that “wild symbols may be used to: replace a line pay symbol, but not replace a scatter pay symbol; replace a scatter pay symbol but not a line pay symbol; replace both scatter and line pay symbols, and the like.” Thus, Singer discloses that wild symbols can replace symbols on a line pay or on a scatter pay. However, Singer does not disclose that the wild symbol replaces winning symbols.

In fact, it does not make sense in Singer to replace a “winning symbol” with a wild symbol because the wild symbol is generally used to turn a non-winning symbol in a potentially

winning symbol. Singer clarifies that wild symbols are “used to replace any or all other symbols to form winning symbol combinations.” Singer, col. 11, ll. 25-27 (emphasis added). In one example, Singer discloses that a player selects a “Scarecrow” symbol – Symbol 7 – to be a wild symbol. Singer, col. 12, ll. 28-49. Because the selected symbol was positioned between four “4” symbols on pay line 4 (**4 7 4 4 4**), the player receives an award as if the player has achieved five symbols of the same kind (**4 4 4 4 4**). *Id.* In contrast, claim 1 is directed to replacing a winning symbol, which in the above example from Singer would mean that a winning “4” symbol would have to be replaced with the wild “7” symbol. However, this is not disclosed (and does not make sense in Singer) because the player’s goal is to change the wild “7” symbol into a winning “4” symbol (not vice versa).

B. The Cited Art Fails To Disclose Identifying Winning Symbols In The Second Array

Claim 1 is further directed to “identifying winning symbols in the second array that form any second winning combination.” The combination of Singer in view of Luciano also fails to disclose this claim element. Claim 10 is further directed to the controller being operative to “identify a second winning symbol in the second array that creates any second winning outcome.”

The Office Action alleges that Singer discloses these claim elements in “fig. 6b,” which has been reproduced below.

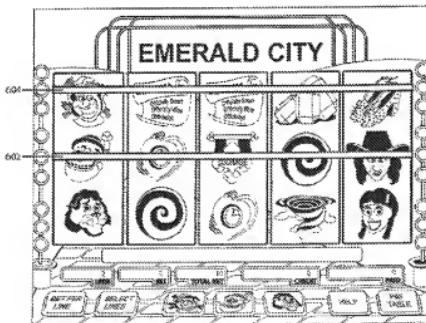


FIG 6B

Nowhere does FIG. 6B of Singer show that (i) any winning symbols are identified in (ii) a second array that forms (iii) a second winning combination. The description of FIG. 6B only discloses that "FIG. 6b shows the second wager is applied to pay line 2 604." The five symbols shown along each pay line 602, 604, are not identified as being winning symbols. Moreover, Singer fails to disclose anywhere else the above listed claim element.

C. The Cited Art Fails To Disclose Awarding For The Second Winning Combination

Claim 1 is further directed to "awarding the player for the second winning combination in the second array." The combination of Singer in view of Luciano also fails to disclose this claim element. Claim 10 is further directed to the controller being operative to "award the player for the second winning outcome."

The Office Action alleges that Singer discloses these claim elements at "col. 3, lines 1-5," which states that the game "provides an award based upon the player's selection of, for example, one or more symbols as wild symbols." Singer does not disclose that the award is for the second winning combination in the second array. Nowhere does Singer disclose the invention of claims 1 and 10.

For the convenience of the Examiner, FIGs. 9 and 10 (with annotations) of the current specification have been included below to illustrate one exemplary embodiment of the invention claimed in claims 1 and 10.

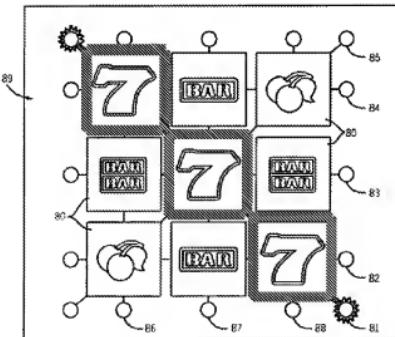


FIG. 9

In the exemplary embodiment of FIG. 9 (above), the winning “7” symbols (further emphasized via added thick lines) are winning symbols that are replaced with randomly selected symbols of FIG. 10 (below) – “Bar Bar” Symbol – “Cherry” Symbol – “7” Symbol. In turn, the new randomly selected symbols form a new winning combination - “Cherry” Symbol - “Cherry” Symbol - “Cherry” Symbol. The current specification provides further details at ¶ 0045.

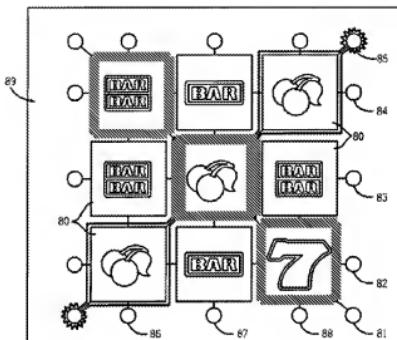


FIG. 10

The Applicant respectfully submits that claims 1 and 10, along with all the claims dependent therefrom, are patentable over Singer at least for the above stated applicable reasons.

II. Rejections In View of Luciano

The rejections of claims 4-8, 12-13, 15-16, and 19 in view of Luciano fail to establish a *prima facie* case of obviousness for the same reasons stated in the previous response of April 30, 2008. As noted above, the Office Action failed to address any of the reasons. The Applicant respectfully submits that claims 4-8, 12-13, 15-16, and 19 are patentable over Singer in view of Luciano for the previously stated (and unaddressed) reasons.

Conclusion

It is the Applicant's belief that all the pending claims are now in condition for allowance, and thus reconsideration of this application is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

A fee of \$130 for the one-month extension of time is being paid upon filing of the current response via the deposit account listed below. It is believed that no other fees are due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247079-000263USPT.

Respectfully submitted,

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